

**REMARKS**

Claims 1, 2, 4, 5, and 10-25 are pending in the present application. Claims 3 and 6-9 were previously cancelled. No new matter has been added.

The Office Action asserts that a restriction is required to one of the following inventions under 35 U.S.C. § 121:

- Invention I: Claims 1-2 and 4-5, drawn to a method for forming dual gate oxides, classified in class 438, subclass 279;
- Invention II: Claims 10-17, drawn to ion implantation method, classified in class 438, subclass 525; and
- Invention III: Claims 18-25, drawn to a method for implanting ions in the active area, classified in class 438, subclass 302.

The Office Action further states that "[b]ecause these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, or III, restriction for examination purposes as indicated is proper." As explained below, this is simply not correct. (It is noted that the Office Action uses "Invention I-III" and "Group I-III" interchangeably. For clarity, Applicants use the "Group" notation.)

For a restriction to be proper, the MPEP states that two criteria must be met.

There are two criteria for a *proper* requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 -§ 806.05(i)); and

(B) There *must* be a *serious* burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) -§ 806.04(i), § 808.01(a), and § 808.02).

(MPEP § 803, 8<sup>th</sup> Edition, 2<sup>nd</sup> Revision, May 2004.) (Emphasis added.)

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"If the search and examination of an entire application *can be made without serious burden*, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions." (MPEP § 803, 8<sup>th</sup> Edition, 2<sup>nd</sup> Revision, May 2004.) (Emphasis added.)

In this case, all three of the Groups I-III identified by the Examiner involve implanting ions into a substrate using a shaded area. As such, a similar search *must be made* for each of the Groups I-III. The assertion to the contrary made by the Examiner that "the search for Group I is not required for Group II, or III" is *simply incorrect*. The search for Group II or III must include the classes/subclasses searched for Group I to be a complete and thorough search. In other words, to search for one group is necessarily similar to a search for the other groups.


As a result, the burden on the Examiner can hardly be considered a "serious burden" as required by the MPEP, and accordingly, Applicants respectfully request that the restriction requirement between Groups I, II, and III be reconsidered and withdrawn, allowing the prosecution to continue on all pending claims 1, 2, 4, 5, and 10-25.

In the alternative, Applicants hereby elect Group I, corresponding to claims 1-2 and 4-5, with traverse, and withdraw claims 10-25 from consideration.

In view of the above, Applicants respectfully submit that the application is in condition for allowance and request that the Examiner pass the case to issuance. If the Examiner should have any questions, Applicants request that the Examiner contact Applicants' attorney at the address below. Please charge any additional fees or credit any overpayments to Deposit Account No. 50-1065.

Respectfully submitted,

January 24, 2005  
Date

  
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